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Practitioner Docket No. NEB-227

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Richard D. Morgan, Paul Walsh

Application No.: 10/617,361

Group No.: 1645

Filed: 07/10/2003

Examiner: not yet assigned

For: Novel Type II Restriction Endonuclease, BtgZI, Obtainable from *Bacillus Thermoglucosidasius* 36A and a Process for Producing the Same

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PETITION TO WITHDRAW HOLDING OF ABANDONMENT UNDER C.F.R. 1.181(a)  
— NOTICE TO FILE MISSING PARTS NOT RECEIVED**

1. I hereby petition to withdraw an expected holding of abandonment in this case, on the basis that the Notice to File Missing Parts was not received by the Applicants.
2. I hereby state:
  - (a) The Notice to File Missing Parts, which apparently was mailed on October 14, 2003 by the USPTO, was not received by Applicants.
  - (b) A search of the file jacket and the docket records in our office indicates that this Notice was not received.

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**CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10\***

*(When using Express Mail, the Express Mail label number is mandatory;  
Express Mail certification is optional.)*

I hereby certify that, on the date shown below, this correspondence is being:

**MAILING**

X deposited with the United States Postal Service in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

**37 C.F.R. § 1.10\***

37 C.F.R. § 1.8(a)  
X with sufficient postage as first class mail.

G as "Express Mail Post Office to Addressee"  
Mailing Label No. \_\_\_\_\_ (mandatory)

**TRANSMISSION**

G facsimile transmitted to the Patent and Trademark Office, (703) \_\_\_\_\_

  
Signature

Date: May 21, 2004

Leslie Goldberg  
(type or print name of person certifying)

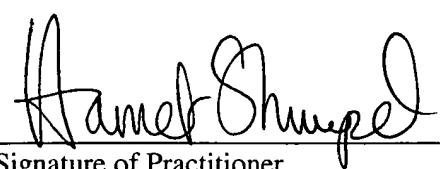
\* Only the date of filing ('1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under '1.8 continues to be taken into account in determining timeliness. See '1.703(f). Consider "Express Mail Post Office to Addressee" ('1.10) or facsimile transmission ('1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

3. We attach a copy of the docket record where the non-received Notice would have been entered had it been received and docketed.
4. As additional evidence of non-receipt of the Notice to File Missing Parts, I also attach:  
Statement from the person who would have handled the Notice had it been received.
5. In consideration of these submissions, it is respectfully requested that the holding of abandonment be withdrawn.
6. Applicants believe that a petition fee is not required under M.P.E.P. 711.03(c). However, should a fee be required by this paper, please charge Deposit Account No. 14-0740.

A duplicate of this paper is attached.

Date: May 21, 2004

Reg. No.: 37,008  
Tel. No.: 978-927-5054, ext. 373  
Customer No.: 28986



Harriet M. Strimpel  
Signature of Practitioner

Harriet M. Strimpel, D. Phil.  
New England Biolabs, Inc.  
32 Tozer Road  
Beverly, MA 01915



## Title

BtgZI A Novel Type II Restriction Endonuclease, BtgZI, Obtainable From ABacillus Thermoglucosidasius 36A And A Process For Producing The Same

## Description

### Current Expense Information

## Other Case-Related Information

#### Actions

Action	Action Due Date	Taken Date	Deadline Date	Completed Date	Responsible Atty #1	Responsible Atty #2	Action Notes
IDS Filed				8/20/2003			
Foreign Filing Review	4/10/2004						
- 9 mo. reminder							
Foreign Filing Review	6/10/2004						
- 11 mo. reminder							
Foreign Filing Completed By		7/10/2004					
Published			1/10/2005				

#### Inventors

Inventor Name Assignment Date

Richard D. Morgan

Paul Walsh

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CreateUser: MAS

UpdateUser: MAS

CreateDate: 6/23/2003

UpdateDate: 9/30/2003

*Copyright 2002 by Master Data Center, Inc.*

Custom Code #7

Attorney

Customer Code

NEPP

Agent

Client\Division

Current Owner

Previous Owner

Text #10

First Filing Date

7/10/2003

Sub Status Date

Parent Filing Date

Parent Grant Date

Application Date

7/10/2003

Grant Date

Publication Date

Ind. Claims\Designs

0

Total Claims

0

TotalClasses

ConfirmationNumber

Tax Base Date

Next Tax Date

Expiration Date

Custom Text #1

Practitioner's Docket No. NEB-227



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Morgan et al.

Application No.: 10/617,361

Group No.: 1645

Filed: July 10, 2003

Examiner: not yet assigned

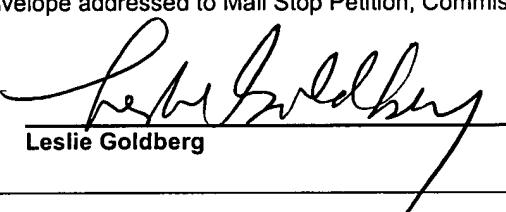
For: Novel Type II Restriction Endonuclease, BtgZI, Obtainable from *Bacillus Thermoglucosidasius* 36A and a Process for Producing the Same

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a)**

I hereby certify that, on the date shown below, this correspondence is being deposited with sufficient postage as first class mail with the United States Postal Service in an envelope addressed to Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

Date: May 21, 2004

  
Leslie Goldberg

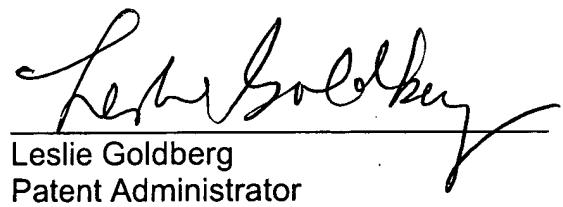
**STATEMENT IN SUPPORT OF PETITION TO WITHDRAW HOLDING OF ABANDONMENT**

I declare that the Filing Receipt (Receipt) and Notice to File Missing Parts (Notice) for the above-referenced application, which purportedly were mailed to our office on October 14, 2003, were in fact never received by this office. A review of our file and docket record for this case (see copy of docket record enclosed) reflects this. As further evidence of non-receipt of the Notice, we also enclose a copy of the declaration and power of attorney and assignment, which were executed by the inventors on August 6 and 11 of 2003 and placed in the file awaiting receipt of the Notice.

Our office became aware that the USPTO issued a Notice with a mailing date of October 14, 2003 on May 11, 2004, the date on which the case was evaluated for prospective foreign filing. On this date, we noticed that the Receipt and Notice were

never received. We contacted the Office of Initial Patent Examination (OIPE). OIPE indicated that these documents were issued and sent a copy of them to our office via facsimile. We then contacted the Petitions Office, presented the facts stated herein, and were advised to prepare the enclosed Petition to Withdraw Holding of Abandonment.

Date: May 21, 2004



Leslie Goldberg  
Patent Administrator

New England Biolabs, Inc.  
32 Tozer Road  
Beverly, MA 01915



DECLARATION  
AND POWER OF ATTORNEY  
Original Application

Attorney Docket No. NEB-227

As a below named inventor, I hereby declare that:

My residence, post address and citizenship are as stated below next to my name

I believe that I am the original, first and sole inventor (in only one name is listed at 201 below) or an original, first and joint inventor (if plural names are listed at 201-203 below) of the subject matter which is claimed and which a patent is sought on the invention entitled:

A NOVEL TYPE II RESTRICTION ENDONUCLEASE, BtgZI, OBTAINABLE FROM BACILLUS  
THERMOGLUCOSIDASIUS 36A AND A PROCESS FOR PRODUCING THE SAME

which is described and claimed in:

the attached specification or  the specification in Application Serial No. 10/617,361 filed 7/10/03  
(for declaration not accompanying application)

And was amended on \_\_\_\_\_  
if applicable

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendments referred to above. I acknowledge the duty to disclose information which is material to the examination of this application in accordance with Title 37, Code of Federal Regulations, §1.56(a). I hereby claim foreign priority benefits under Title 35, United States Code, §119 of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed:

FOREIGN APPLICATION(S) IF ANY, FILED WITHIN 12 MONTHS PRIOR TO THE FILING DATE OF THIS APPLICATION			
COUNTRY	APPLICATION	DATE OF FILING (day, month, year)	PRIORITY CLAIMED UNDER 35 U.S.C. 119
			YES NO
			YES NO

ALL FOREIGN APPLICATION(S) IF ANY, FILED MORE THAN 12 MONTHS PRIOR TO THE FILING DATE OF THIS APPLICATION

COUNTRY	APPLICATION	(day, month, year)	PRIORITY CLAIMED UNDER 35 U.S.C. 119

I hereby claim the benefit under Title 35, United States Code §120 of any United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code §112, I acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulations, §1.56(a) which occurred between the filing date of the prior application and the national or PCT international filing date of this application:

Application Serial No.	Filing Date	Status (Patented, Pending, Abandoned)

DECLARATION  
AND POWER OF ATTORNEY  
PAGE 2 OF 3

**POWER OF ATTORNEY:**

As a named inventor, I hereby appoint the following attorney with full powers of association, substitution and revocation to prosecute this application and transact all business in the Patent and Trademark Office connected therewith:

Gregory D. Williams  
(Registration No. 30901)

Harriet M. Strimpel  
(Registration No. 37008)

**SEND CORRESPONDENCE TO:**

Gregory D. Williams  
General Counsel  
New England Biolabs, Inc.  
32 Tozer Road  
Beverly, MA 01915

**DIRECT TELEPHONE CALLS TO:**

Harriet M. Strimpel  
Patent Counsel  
New England Biolabs, Inc.  
Tele: (978) 927-5054; Ext. 373  
Fax: (978) 927-1705

2	Full Name of Inventor	Last Name Mörgan	First Name Richard	Middle Name D.
0	Residence & Citizenship	City Middleton	State/Foreign Country Massachusetts	Citizenship US
1	Post Office Address	Post Office Address 31 Donovan's Way	City/State/Country Middleton, MA	Zip Code 01949
2	Full Name of Inventor	Last Name Walsh	First Name Paul	Middle Name
0	Residence & Citizenship	City Boston, MA	State/Foreign Country Massachusetts	Citizenship US
2	Post Office Address	Post Office Address 32 Union Park #4	City/State/Country Boston, MA	Zip Code 02118
2	Full Name of Inventor	Last Name	First Name	Middle Name
0	Residence & Citizenship	City	State/Foreign Country	Citizenship
3	Post Office Address	Post Office Address	City/State/Country	Zip Code
2	Full Name of Inventor	Last Name	First Name	Middle Name
0	Residence & Citizenship	City	State/Foreign Country	Citizenship
4	Post Office Address	Post Office Address	City/State/Country	Zip Code
2	Full Name of Inventor	Last Name	First Name	Middle Name
0	Residence & Citizenship	City	State/Foreign Country	Citizenship
5	Post Office Address	Post Office Address	City/State/Country	Zip Code

## DECLARATION

## AND POWER OF ATTORNEY

PAGE 3 OF 3

206	Full Name of Inventor	Last Name	First Name	Middle Name
	Residence & Citizenship	City	State/Foreign Country	Citizenship
	Post Office Address	Post Office Address	City/State/Country	Zip Code
207	Full Name of Inventor	Last Name	First Name	Middle Name
	Residence & Citizenship	City	State/Foreign Country	Citizenship
	Post Office Address	Post Office Address	City/State/Country	Zip Code
208	Full Name of Inventor	Last Name	First Name	Middle Name
	Residence & Citizenship	City	State/Foreign Country	Citizenship
	Post Office Address	Post Office Address	City/State/Country	Zip Code
209	Full Name of Inventor	Last Name	First Name	Middle Name
	Residence & Citizenship	City	State/Foreign Country	Citizenship
	Post Office Address	Post Office Address	City/State/Country	Zip Code

I hereby further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true and further that these statements were made with the knowledge that willful statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

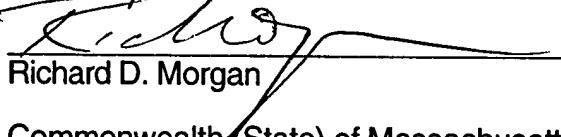
Signature of Inventor 201 	Date 6 AUGUST 03
Signature of Inventor 202 	Date 11 AUGUST 03
Signature of Inventor 203	Date
Signature of Inventor 204	Date
Signature of Inventor 205	Date
Signature of Inventor 206	Date
Signature of Inventor 207	Date
Signature of Inventor 208	Date
Signature of Inventor 209	Date

## ASSIGNMENT

We, Richard D. Morgan and Paul Walsh for good and valuable consideration from New England Biolabs, Inc., a Massachusetts Corporation, having its principal place of business in Beverly, Massachusetts, hereinafter called the Assignee, receipt of which is hereby acknowledged, do hereby sell, assign and transfer unto the Assignee, its successors and assigns, the entire right, title, and interest in, to and under an application for Letters Patent of the United States Serial No. 10/617,361, signed by me on uneven date herewith for improvements **A NOVEL TYPE II RESTRICTION ENDONUCLEASE, BtgZI, OBTAINABLE FROM BACILLUS THERMOGLUCOSIDASIUS 36A AND A PROCESS FOR PRODUCING THE SAME** including all priority rights ensuing therefrom, and the inventions and any of them therein set forth and described, and any and all Letters Patent of the United States and of countries foreign thereto which may be granted thereon or therefor, together with the right to apply for such Letters Patent.

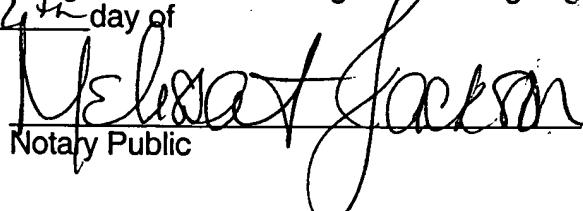
And for the above consideration I agree promptly upon request of the Assignee, its successors or assigns, to execute and deliver without further compensation any power of attorney, assignment, application, whether original, divisional, continuation or reissue, or other papers which may be necessary or desirable to secure to the Assignee, said application and all patent rights therein, in the United States and in any country foreign thereto.

IN WITNESS THEREOF, I, Richard D. Morgan, hereunder set my hand and seal this 14<sup>th</sup> day of August, 2003, and I, Paul Walsh, hereunder set my hand and seal this 14<sup>th</sup> day of August, 2003.

  
Richard D. Morgan

Commonwealth (State) of Massachusetts  
County of Essex ss.

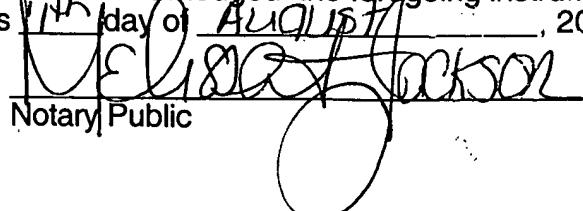
Before me personally appeared said Richard D. Morgan and acknowledged the foregoing instrument of assignment to be his free act and deed this 14<sup>th</sup> day of August, 2003.

  
Nelson Jackson  
Notary Public

  
Paul Walsh

Commonwealth (State) of Massachusetts  
County of Essex ss.

Before me personally appeared said Paul Walsh and acknowledged the foregoing instrument of assignment to be [her] his free act and deed this 14<sup>th</sup> day of August, 2003.

  
Nelson Jackson  
Notary Public